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**OFFICE OF PETITIONS**

In re Application of :  
Lai et al. :  
Application Number: 10/765383 : ON PETITION  
Filing Date: 01/27/2004 :  
Attorney Docket Number: :  
INTV.020A :

This is a decision in reference to the paper entitled "REQUEST FOR REINSTATEMENT OF PATENT APPLICATION TO A PENDING STATE AND THE ISSUANCE OF A CORRECTED OFFICIAL ACTION," filed on May 14, 2008, which, in view of petitioner's statements therein, is treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment.

The petition is **DISMISSED**.

This application became abandoned on November 18, 2007, for failure to timely submit a proper reply to the non-final Office action mailed on August 17, 2007, which set a three (3) month shortened statutory period for reply. Notice of Abandonment was mailed on March 19, 2008.

Petitioners state that the Office action mailed on August 17, 2007, was incorrect, and that applicants' attorney contracted the examiner and informed him "that the Official Action was incorrect and that no report could be generated to the client nor could any response be made to the Official Action."

Petitioners' counsel further states that a new Office action was promised by the examiner then assigned to the case, Examiner Mitiku Debelie, in a telephone call on August 27, 2007. However, no new Office action was mailed, and the application was subsequently held abandoned.

Petitioner's argument has been considered, but is not persuasive.

37 CFR 1.135 states, in pertinent part.

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require.

Further, the Office action mailed on August 17, 2007, states that a shortened statutory period for reply is set to expire 3 months ... from the mailing date of this communication. Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

37 CFR 1.2 states that the action of the U.S. Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The showing of record is that petitioners did not timely file a proper reply to the non-final Office action mailed on August 17, 2007.

With regard to petitioners' assertion that the examiner agreed to provide a new Office action, there is no evidence in the record to support that contention. Furthermore, there is no showing that petitioners timely filed a response to the non-final Office action mailed on August 17, 2007.

Abandonment takes place by operation of law for failure to timely submit a proper reply to an Office action.<sup>1</sup> The rule clearly indicates that a proper written response must be timely filed to save the application from abandonment. Thus, the application became abandoned due to petitioner's failure to file a timely and proper response to the non-final Office action mailed August 17, 2007, and not because of any error on the part of the Office.

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<sup>1</sup> MPEP 711.03(c). See Lorenz v. Finkl, 333 F.2d 885, 889-90, 142 USPQ 26, 299-300 (CCPA 1964); Krahn v. Commissioner, 15 USPQ2d 1823, 1824 (E.D. Va. 1990); In re Application of Fischer, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

In summary, to the extent that petitioner's counsel believed that the examiner had agreed that no further action was needed to avoid abandonment of the application, there is no showing in the written record to support that allegation. As MPEP 711.03(c) states, a delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (A) the applicants' reliance upon oral advice from USPTO employees; or (B) the USPTO's failure to advise the applicants of any deficiency in sufficient time to permit the applicant to take corrective action.<sup>2</sup>

The U.S. Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions.<sup>3</sup> Specifically, petitioner's delay caused by the mistakes or negligence of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 U.S.C. § 133.<sup>4</sup>

As such, the showing of record is that the abandonment resulted from the failure of petitioners to file a timely and proper response to the non-final Office action, rather than an error on the part of the USPTO.

As such the application is properly held abandoned.

The petition is **DISMISSED.**

Petitioner may wish to consider filing a petition to revive under 37 C.F.R. 1.137(b).

Any request for reconsideration must be filed within **TWO (2) MONTHS** of the date of this decision. **This time period may not be extended.** 37 CFR 1.181(f).

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<sup>2</sup> See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

<sup>3</sup> Link v. Wabash, 370 U.S. 626, 633-34 (1962).

<sup>4</sup> Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N. D. Ind. 1987); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891).

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